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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,564	07/19/2001	Gunter Schmidt	P-0279469/20	1520

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 01/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/806,564

Applicant(s)
Schmidt

Examiner
David Lukton

Art Unit
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 1, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 18-24 is/are pending in the application.
- 4a) Of the above, claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-13, 18-20, 23, and 24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Applicants' election of Group I (claims 1-15) with traverse is acknowledged.

Pursuant to preliminary amendment, claims 14-17 have been cancelled, and claims 18-24 added. Claims 1-13 and 18-24 are pending. Pursuant to applicants' election, claims 21-22 are withdrawn from consideration. Applicants have traversed by arguing that both groups are closely related, and that the searches would be co-extensive. Applicants' argument is not without merit; if Group I (now Group III) is determined to be novel in its present form, then novelty would likely accrue to the Group II claims. However, in the event that Group I (now Group III) is not novel in its present form, additional searching would have to be undertaken to examine the Group II claims. Accordingly, in the event that Group III (or Group IV) is determined to be novel in its present form, or in amended form, there is a significant possibility that Group II would be rejoined therewith; certainly the matter would have to be revisited at that point. Of course, any limitations that have been introduced into the Group III (or Group IV) claims would have to be introduced into the Group II claims prior to rejoining.

In view of the change of examiners, the restriction requirement is revised as set forth below.

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Restriction to one of the following inventions is required under 35 U.S.C. §121 (the

numbering begins with "III" to avoid conflict with any previous groupings):

III. Claims 1, 2, 9-13, 18, 20, 23, 24, drawn to a method of analysis, with the proviso that capping steps are excluded.

IV. Claims 3-13, 18-20, 23, 24, drawn to a method of analysis in which a capping step is mandated.

The claimed inventions are distinct.

Group IV requires a capping step, whereas Group III does not. Accordingly, these two groups are distinct. However, in the event that Group III is elected, and claims therein found allowable, it is quite possible that novelty would accrue to the Group IV invention. Regardless of which of the two groups (Group III or IV) is elected, the possibility of rejoining the other group (of the two) is not precluded by the fact of initial restriction. Given the relatensess of the two inventions, one could argue that the examiner should provide at least one reference which would be applicable to one of the two groups but not the other. For the time being, it is asserted that justification exists for the grouping of claims set forth above.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect various species as set forth below.

In the event that group III is chosen for initial examination, election of each of the following is required:

- (a) a first cleavage agent (e.g., cyanogen bromide or trypsin)
- (b) a second cleavage agent (e.g., cyanogen bromide or trypsin)
- (c) a specific solid phase support (e.g., DITC glass or polystyrene isothiocyanate) that is used to isolate the peptide fragments
- (d) the bonding of the peptide fragments to the solid phase support is one of the following:
 - (i) bonding of the peptide at its C-terminus, or (ii) bonding of the peptide at its N-terminus.

....

In the event that group IV is chosen for initial examination, election of each of the following is required:

- (a) a first cleavage agent (e.g., cyanogen bromide or trypsin);
- (b) a second cleavage agent (e.g., cyanogen bromide or trypsin);
- (c) a "first" capping agent (e.g., iodoacetate or phenylisocyanate);
- (d) a "second" capping agent (e.g., trimethylsilylchloride or acetic anhydride);
- (e) a specific functional group in the peptide that is capped (e.g., the *epsilon*-amino group of lysine);

(f) a specific solid phase support (e.g., DITC glass or polystyrene isothiocyanate) that is used to isolate the peptide fragments;

(g) the bonding of the peptide fragments to the solid phase support is one of the following:

(i) bonding of the peptide at its C-terminus, or (ii) bonding of the peptide at its N-terminus.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


DAVID LUKTON
PATENT EXAMINER
GROUP 1300